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ROTHWELL, FIGG, ERNST &
MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

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OFFICE OF PETITIONS

In re Patent No. 7,535,457	:	
Caplan et al.	:	
Issue Date: May 26, 2009	:	
Application No. 10/646,271	:	DECISION ON REQUEST FOR
Filed: August 22, 2003	:	RECONSIDERATION OF
Attorney Dkt. No. 0010.0006	:	PATENT TERM ADJUSTMENT
Title: Method and System For	:	
Special Examination of Vascular	:	
Walls Through Blood During	:	
Cardiac Motion	:	

This is in response to the "Petition to Correct Patent Term Adjustment" filed June 26, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentees request that the patent term be adjusted from 843 days to 1294 days.

The request for reconsideration of patent term adjustment is DISMISSED.

On May 26, 2009, the above-identified application matured into US Patent No. 7,539,530 with a patent term adjustment of 830 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that 174 days overlap between the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), and the

period of adjustment due to examination delay, pursuant to 37 CFR § 1.702(a), as these periods occur on the same day. Thus, patentees request that the determination of patent term adjustment be increased from 830 days to 1294 days.

Patentees submit that the total period of adjustment for Office delay is the sum of the period of three-year delay (638 days) and the period of examination delay (843 days) to the extent these periods do not overlap. As such, patentees assert entitlement to a patent term adjustment of 1294 days (843 days plus 638 days less 174 days of overlap less 13 days of applicant delay).

The Office finds that as of the filing of the request for continued examination (RCE) on May 21, 2008, the application was pending three years and 638 days after its filing date. An entry of a period of adjustment of 843 days was entered for Office delay. Further, an undisputed reduction of 13 days for applicants' failure to engage in reasonable efforts to conclude prosecution was taken. At issue is whether patentees should accrue an additional 638 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 843 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 638 days overlap. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.*

154 (b) (2) (A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b) (2) (A) as permitting either patent term adjustment under 35 U.S.C. 154(b) (1) (A) (i)-(iv), or patent term adjustment under 35 U.S.C. 154(b) (1) (B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b) (1) (A) (i)-(iv) and 154(b) (1) (B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b) (1) (B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b) (1) (B) (i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b) (1) (B) in determining whether periods of delay overlap under 35 U.S.C. 154(b) (2) (A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b) (1) (B), 35 U.S.C. 154(b) (2) (A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b) (2) (A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b) (1) (B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b) (2) (A) is the filing date August 22, 2003 until the filing of the RCE on May 21, 2008. Prior to the issuance of the patent, 843 days of patent term adjustment were

accorded for the Office failing to respond within a specified time frame during the pendency of the application.

The Office did not delay 843 days and then delay an additional 638 days. Accordingly, 843 days of patent term adjustment for Office delay (not 843 days and 638 days) was properly entered because the entire period of delay of 638 days attributable to the delay under 37 CFR 1.702(b) overlaps with the 843 days attributable to grounds specified in § 1.702(a)(1).

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent was 830 days (843-13).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

Christina Partea Donnell for

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration